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Number of Pages Including this Page: 6

1) Response to Office Action Summary dated February 26, 2003 (5 pgs.)

2)

Inventor(s): Junan Kao, et al.

3)

S.N.: 09/715,354

4)

Filed: November 17, 2000

Case: 8322R

Comments:

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Amdt Dated May 23, 2003
Reply to Office Action of February 26, 2003

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P&G Case 8322R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: :
JUNAN KAO ET AL. : Confirmation No.: 6333
Serial No.: 09/715,354 : Group Art Unit: 1731
Filed: November 17, 2000 : Examiner: Peter Chin
For: TENSION ACTIVATABLE SUBSTRATE

RESPONSE TO OFFICE ACTION DATED FEBRUARY 26, 2003

Honorable Commissioner for Patents

P.O. Box 1450

Arlington, VA 22313-1450

Dear Sir:

In response to the Office Action of February 26, 2003, please consider the following remarks.

REMARKS

1. **Rejection Under 35 USC 112, first paragraph**

Claims 1, 6-20, 24 and 25 are rejected under 35 USC 112, first paragraph, as based on a disclosure which is not enabling. The Examiner has cited *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) in support of this rejection. In the cited case, method claims were found to be invalid for want of a step deemed by the court to be essential to the practice of the invention. Unlike the cited case, Applicants claim a product not a method. The law is clear that the enablement requirement is met if the description enables any mode of making and using the invention *Durel Corp. v. Osram Sylvania Inc.* 256 F.3d 1298, 1308, 59 USPQ2d 1238, 1244 (Fed. Cir. 2001). Applicants submit that the enablement requirement for the claimed invention is satisfied because the description of the instant application discloses at least one method of making and using the claimed tissue paper that satisfies the stated claim limitations, (Spec. pages 9-20).

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The Examiner refers to "apertures, perforations, slits, or cuts critical or essential to the practice of the invention, but not included in the claims." The Federal Circuit has held that there is no essential element test mandating an inquiry into what an inventor considers to be essential to his invention and requiring that the claims incorporate those elements *See Amgen Inc., v Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 65 USPQ2d (BNA) 1385 (Fed. Cir. 2003) citing *Cooper Cameron Corp. v. Kvaerner Oilfield Prods. Inc.*, 291 F.3d 1317, 1323, 62 USPQ2d 1846, 1850-51 (Fed. Cir. 2002).

The enablement requirement of 35 USC 112 has been satisfied. Applicants request that the rejection under 35 USC 112 first paragraph be withdrawn.

2. **Rejection Under 35 U.S.C. 102**

Claims 1-5, 15 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375] Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzinger et al [U.S. Patent No. 2,950,223]. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegai Bros., 814 F.2d at 631 (Fed. Cir. 1987), MPEP §2131. "The identical invention must be shown in as complete detail as is contained in the ...claim." Richardson, 868 F.2d at 1236 (Fed. Cir. 1989), MPEP §2131. Applicants respectfully submit that these rejections are improper because none of the references cited by the Examiner either expressly or inherently contain each and every element set forth in claims 1-5, 15, and 16.

The Examiner has concluded that "while the prior references are silent as to the claimed ability to expand upon application of tensile force, it is inherent that the prior art has the claimed property because the same kind of slit or perforations as presently disclosed for the claimed paper is used or present in the prior art paper." (06/06/02 Final Office Action, Page 2) The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ 2d 1955 (Fed. Cir. 1993), In re Oelrich, 666 F.3d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981), MPEP § 2112. "To establish inherency, the **extrinsic evidence** 'must **make clear** that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added), MPEP §2112. When an Examiner relies on the theory of inherency, the Examiner is required to "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied

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prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has simply stated that the “cited references show absorbent tissue paper and towel that have slits or perforations going through the thickness of the paper.” (6/06/02 Final Office Action, Page 2) The Examiner further states that “the present invention achieves the claimed increase in the z-direction or thickness upon application of tensile force in the x/y direction through the use or presence of slits and perforations in the absorbent paper...” (6/06/02 Final Office Action, Page 2) The Examiner has failed to provide a basis in fact or technical reasoning to support that the “slits or perforations going through the thickness of the paper” disclosed in the cited art would necessarily result in the claimed expansion in the z-direction. Additionally, Examiner has failed to show that the z-direction expansion would necessarily flow from the teachings of the cited art.

The Examiner has admitted that the “prior references are silent to the claimed ability to expand upon application of tensile force...” (06/06/02 Final Office Action, Page 2) The tissue paper of the present invention comprises a substrate that can be activated by a consumer. (Specification, Page 4, Lines 8-10) Once activated, the tissue paper can increase in thickness in a greater proportion than it increases in elongation. (Specification, Page 5, Lines 6-13 and Claim 1) In one embodiment, after activation, the tissue product increases at least four times in thickness. (Claim 8)

Applicants respectfully submit that the anticipation rejection under 35 U.S.C. §102(b) is improper because each and every element of the claimed invention is not disclosed in the art cited by the Examiner, as no cited art teaches z-direction expansion.

3. Rejecton Under 35 USC 103(a)

Claims 1-7, and 15 - 17 are rejected under 35 U.S.C. §103(a) as obvious over Morgan et al [U.S. Patent No. 3,994,771], Bredendick et al [U.S. Patent No. 5,861,081], Tseng et al [U.S. Patent No. 5,652,035], Atkins [U.S. Patent No. 2,130,375] Milliken [U.S. Patent No. 2,113,431], Milliken [U.S. Patent No. 2,281,945], or Bletzinger et al [U.S. Patent No. 2,950,223]. The Examiner concludes that “while the prior references are silent as to the claimed ability to expand upon application of tensile force, it is inherent that the prior art has the claimed property because the same kind of slit or perforations as presently disclosed for the claimed paper is used or present in the prior art paper.” The Examiner further concludes that the claimed density, thickness, and coefficient of friction would have been the obvious result of forming the sheets of prior art into multiply ply products, and that the coefficient of friction is an obvious result of optimizing the blends of hardwood and softwood fibers and softening agents.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, the prior art reference (or references when combined) must teach

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or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Third, there must be a reasonable expectation of success of obtaining the claimed invention based upon the references relied upon by the Examiner. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness, as the Examiner has failed to indicate where a teaching of expansion, of the claimed density and thickness, and the claimed coefficient of friction, either explicit or implicit, appears in the cited references, and thus the cited references fail to teach or suggest all the claimed limitations. See In re Rijckaert, 9 F.3d at 1534. Additionally, the Examiner has failed to point to a suggestion or motivation to modify the references or combine reference teachings to include tissue paper expansion in the z-direction. Finally, the examiner has failed to point to a reference which teaches a reasonable expectation of success. Therefore, the obviousness rejection is improper.

A. The references do not teach or suggest all the claim limitations:

The Examiner states that "the prior references are silent as to the claimed ability to expand upon application of tensile force..." (06/06/02 Final Office Action, Page 2). To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the present case the cited references do not teach or suggest all the elements of the claimed invention, as none of the cited references teach or suggest the expansion in the z-direction. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency]." In re Oelrich, 666 F.2d at 581-82 (emphasis added). Even if inherency were to be established, "that which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." In re Spormann, 363 F.2d 444, 448 (CCPA 1966). Accordingly, because all the claim limitations are not taught or suggested by the references cited by the Examiner, the Applicants assert the conclusion of obviousness is improper.

B. There is no motivation to modify or combine the references:

Obviousness can only be established by combining or modifying reference teachings to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1491 (Fed. Cir. 1992). In the present case, the Examiner has failed to reference any teachings which would suggest the modification of art to produce the claimed invention. For the references to include an implicit motivation to modify the

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references to arrive at the claimed invention, the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole must have been suggested to one of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000), MPEP §2143.01. The Examiner has failed to establish where the teaching in art, knowledge of one of ordinary skill, or the nature of the problem to be solved existed such that it could be suggested to one of ordinary skill in the art. Additionally, the mere fact that references can be modified is not sufficient to establish obviousness. The prior art must also suggest the desirability of doing so. In re Mills, 916 F.2d 680 (Fed. Cir. 1990). The Examiner has failed to point out where the referenced art teaches the desirability of creating a tissue paper product which once activated, is transformed from the first state of intensive properties to the second state of intensive properties. Thus, the modification of the references, and the conclusion that the present invention is obvious is improper.

C. There is not a reasonable expectation of success of obtaining the claimed invention based upon the references:

References may be modified or combined to reject claims as *prima facie* obvious only if there is a reasonable expectation of success that the claimed invention will result. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicants assert that no art has been provided by the Examiner which points to a reference teaching a reasonable expectation of success of z-direction expansion, as no art cited by the Examiner teaches explicitly or implicitly the claimed z-direction expansion.

Therefore, based upon the references cited, the Examiner has failed to establish that a person of ordinary skill would have a reasonable expectation of success of obtaining the claimed invention, and thus Applicants assert the obviousness rejection is improper.

4. Conclusion

The rejections under 35 USC 112 first paragraph s not properly supported and should be withdrawn. The rejections under 35 USC 102(b) are not based on art that anticipates all of the claimed limitations and should be withdrawn. The Examiner has failed to establish a *prima facie* case of obviousness under 35 USC 103(a) and the obviousness rejection should be withdrawn.

Respectfully submitted,

FOR: JUNAN KAO, et al.

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Date: 5/23/03

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